

Appl. No. 10/613,139
Reply to Office Action of August 10, 2005

Attorney Docket No. 2003-0329/24061.70
Customer No. 42717

REMARKS

The Abstract has been amended. In view of the foregoing amendment, and the remarks that follow, Applicants respectfully request reconsideration.

Objection to Abstract

The Office Action objected to the Abstract, identifying two problems and suggesting appropriate corrections. The foregoing amendments to the Abstract implement the changes suggested by the Examiner. It is respectfully submitted that the Abstract is now in proper form, and notice to that effect is respectfully requested.

Claim Rejections under 35 U.S.C. §102

The Office Action rejects Claims 1-28 under 35 U.S.C. §102 as anticipated by Berg U.S. Patent Application Publication No. 2002/0022969. This ground of rejection is respectfully traversed, for the following reasons.

As explained in MPEP §2131, anticipation under §102 requires the presence in a single prior art reference of each and every element of the claimed invention, and the elements in the reference must be arranged as required by the claim. In other words, the reference underlying a §102 rejection must do more than merely disclose each and every element recited in the claim. The reference must disclose all of those elements in a single embodiment that contains the entire combination recited in the claim, including all recited interrelationships between recited elements.

This requirement in MPEP §2131 is a result of decisions by the federal courts and by the Board of Appeals. For example, the Court of Appeals for the Federal Circuit has consistently held that:

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Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed.Cir. 1984), citing *Connell v. Sears Roebuck & Co.*, 220 USPQ 193 (Fed.Cir. 1983). (Emphasis added).

In *Lindemann*, the Federal Circuit struck down a finding of anticipation, emphasizing that the underlying analysis was erroneous to the extent that it "treated the claims as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning". *Lindemann* at 486.

Within the Patent Office, the Board of Appeals adheres to precisely the same requirement. For example, an examiner used a reference to Partington as the basis for a §102 rejection of claims presented by an applicant named Gould. Partington disclosed all of the claimed elements, but not in a single embodiment having all of the recited interrelationships between elements. Gould appealed the rejection, and the Board of Appeals reversed the rejection. The Board explained that:

Gould has argued throughout the prosecution of this case that, while all the elements of his claimed device were known (and are shown in Partington), the elements were not arranged in the manner required by the claims. We agree. *Ex parte Gould*, 6 USPQ2d 1680, 1682 (Bd.Pat.App. & Int'l. 1987). (Emphasis added).

In the present application, the Berg publication discloses various separate and distinct embodiments, including (1) the embodiment of Figures 1-3, (2) the embodiment of Figure 4,

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(3) the embodiment of Figures 5-8, and (4) the embodiment of Figure 9. The Abstract of Berg is not directed specifically to any single one of these embodiments, but instead is a generalized discussion of some features that are common to at least some of the embodiments.

Beginning with Applicants' three independent claims (Claims 1, 9 and 17), an explanation of the §102 rejection of these claims appears in the paragraph that bridges pages 2-3 of the present Office Action. In explaining this §102 rejection, the paragraph selectively draws teachings from (1) the Abstract of Berg, (2) the embodiment of Figure 7 of Berg, and (3) the embodiment of Figure 9 of Berg. Thus, the §102 rejection of the independent claims is not based on a single embodiment of Berg, as required by §102 and by MPEP §2131, but instead is based on at least two different embodiments in Berg (and possibly three or more different embodiments in Berg). Stated differently, this §102 rejection draws isolated structural features from two or more distinct embodiments, and then combines them to make the rejection. The Examiner has apparently assumed that, in a §102 rejection based on a single reference, any and all teachings in the reference can be freely used in making the rejection. However, this is exactly what the examiner did in the above-mentioned *Gould* case, and that approach has been flatly rejected by the Board of Appeals and by the federal courts. This is due in part to the fact that any attempt to combine two or more embodiments raises issues of obviousness under 35 U.S.C. §103, even if the embodiments are all in the same reference. The present rejection is based on §102 rather than §103, and does not even attempt to meet the PTO's requirements for establishing a *prima facie* case of obviousness under §103.

Turning now to the dependent claims (Claims 2-8, 10-16 and 18-28), the §102 rejection in the present Office Action selectively combines teachings drawn from a variety of different embodiments in Berg. More specifically, the Office Action selectively combines teachings drawn from (1) the Abstract of Berg, (2) an embodiment mentioned in paragraph [0008] of the Summary of the Invention section, (3) another embodiment mentioned in paragraph [0012] of the Summary of the Invention section, (4) the embodiment of Figures 1-3, including paragraphs [0023, 0026, 0029, 0035, and 0036], (5) the embodiment of Figures 5-8, including

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Figure 7 and paragraphs [0041 and 0042], and (6) the embodiment of Figure 9, including paragraph [0046]. As discussed above, this approach does not even remotely satisfy the requirements of §102 and MPEP §2131. As to each of Claims 1-28, the Office Action fails to identify a single embodiment in Berg that includes the entirety of the subject matter recited in the claim, including not only all of the recited elements, but also all of the recited interrelationships between the recited elements. In other words, the Examiner has not met the requirement of establishing that Berg discloses "every element of the claimed invention, arranged as in the claim".

Thus, the §102 rejection of Claims 1-28 fails to meet the requirement noted by the Federal Circuit in *Lindermann*, adhered to by the PTO Board in *Gould*, and reiterated by the PTO in MPEP §2131. Stated differently, Claims 1-28 of the present application are not anticipated by the Berg reference for the same basic reason the Board of Appeals ruled that Gould's claims were not anticipated by the Partington reference. Accordingly, it is respectfully submitted that the §102 rejection of Claims 1-28 is not proper and must be withdrawn, and notice to that effect is respectfully requested. If the Examiner wishes to continue to rely on combinations of elements drawn selectively from multiple different embodiments in Berg, the Examiner would need to present those rejections under §103 rather than §102, and would need to meet the PTO's requirements for establishing a *prima facie* case of obviousness under §103.

Claims 1-28 are not subject to any other ground of rejection. It is therefore respectfully submitted that Claims 1-28 are allowable, and notice to that effect is respectfully requested.

Conclusion

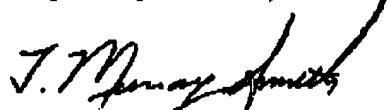
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8647.

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Although Applicants believe that no fee is due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



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Date: November 8, 2005

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Enclosures: None

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